

Appl. No. 10/535,287
Amendment and/or Response
Reply to Office Action of December 20, 2008

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Amendments to the Drawing Figures:

The attached drawing sheet(s) include proposed changes to FIG. 2. This is a new drawing showing, conceptually, an electrical domestic appliance having a heating element.

The new drawing adds no new matter as the filed application, at least by claim 13, provides support for the drawing.

Attachment: Replacement Sheet 1/1.

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REMARKS/DISCUSSION OF ISSUES

Claims 1-2 and 4-14 are pending in the application.

Applicants respectfully request that the Examiner acknowledges the claim for priority and receipt of certified copies of all the priority document(s).

The Examiner is respectfully requested to state whether the drawings are acceptable.

Claims are amended for non-statutory reasons, to replace European-style claim phraseology with American-style claim language. The claims are not narrowed in scope and no new matter is added.

Non-Compliance

Applicants submit herewith a Response, which in substance is identical to the earlier filed response, but includes the inadvertently omitted Replacement Sheet of Drawings.

Newly Added Drawing

Applicants provide herewith Replacement Sheet 1/1, which includes added Fig. 2. The drawing adds no new matter as noted above. Acceptance of this drawing is earnestly solicited.

Rejections under 35 U.S.C. § 102

Claims 1, 2 and 4-14 are rejected under 35 U.S.C. § 102(b) as being unpatentable over *DeCamp, et al.* (U.S. Patent 4,920,254). For at least the reasons set forth herein, Applicants respectfully submit that this rejection is improper and should be withdrawn.

Applicants rely at least on the following standards with regard to proper rejections under 35 U.S.C. § 102. Notably, a proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983).

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Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *See, e.g., In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Alternatively, anticipation requires that each and every element of the claimed invention be embodied in a single prior art device or practice. *See, e.g., Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

Claim 1 is drawn to a heating element and features:

"...an electrically insulating layer and an electrically conductive layer, wherein at least the electrically conductive layer is based on a hybrid sol-gel precursor comprising an organosilane compound."

Claim 13 is drawn to an electrical domestic appliance and includes a similar feature.

The Office Action alleges that all the claims are clearly anticipated by *DeCamp, et al.* The Office Action provides no further explanation or articulation in support of this position.

While Applicants have provided a basis in law for the standard of anticipation, Applicants are unaware of the standard in law of clear anticipation. Regardless, Applicants respectfully submit that the present rejection fails to comply with MPEP § 706. To this end, a basic goal of examination as set forth in MPEP § 706 is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. Applicants respectfully submit that a rejection has not been clearly articulated.

The applied art includes 3 drawing figures and over 12 columns of disclosure. Yet, the Office Action fails to recite even one reference character or line in the disclosure

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that allegedly clearly anticipates the claims under consideration. Applicants respectfully submit that this places Applicants in the prejudicial position of having to review the applied art and attempt to determine that which the Examiner believes clearly anticipates the rejected claims. Respectfully, this shifts the burden to the Applicants to provide evidence of patentability without the benefit of a clearly articulated rejection. Applicants submit that this is improper.

Moreover, Applicants have paid the required fees and have complied with the requirements of filing of a utility application, and thus are entitled to full and complete examination of the present application, including specific recitation, if any, of features of the applied art that allegedly anticipate the claims under examination. Unless a rejection in compliance with the standards of law and the guidelines of the MPEP noted above can be provided, Applicants respectfully submit that they are entitled to a patent as a matter of law.

The above notwithstanding, Applicants respectfully submit that the applied art fails to disclose at least the noted features of claims 1 and 13.

With regard to claim 1, the applied art does not disclose a hybrid sol-gel precursor as specifically featured in both claims 1 and 13. Notably, Applicants have conducted a key-word search of the terms 'sol', 'gel', and 'hybrid' in the applied art; and have reviewed the patent in an attempt to determine whether these and other features are disclosed. The fruits of this search were barren. Therefore, Applicants respectfully submit that the applied art fails to disclose at least the noted feature of claims 1 and 13.

With particular regard to claim 13, Applicants respectfully submit that the applied art also fails to disclose the electrical domestic appliance. The reference does disclose heated glass windows. While heated glass windows are useful in many settings, they are hardly functional as domestic appliances. Therefore, because the applied art fails to disclose at least one feature of claim 13, a prima facie case of anticipation based thereon cannot be established. Finally, while claim 14 is patentable over the applied art for at least the same reasons as claim 13, Applicants respectfully submit that none of the featured appliances are disclosed in the applied art.

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For at least the reasons set forth above, claims 1 and 13 are patentable over the applied art. Moreover, claims 2 and 4-11 and 14, which depend from claims 1 and 13 as delineated above, are patentable over the applied art for at least the same reasons.

CONCLUSION

In view of the foregoing explanations, Applicant(s) respectfully request(s) that the Examiner reconsider and reexamine the present application, allow claims 1, 2 and 4-14 and pass the application to issue. In the event that there are any outstanding matters remaining in the present application, the Examiner is invited to contact William S. Francos (Reg. No. 38,456) at (610)375.3513 to discuss these matters.


If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment (except for the issue fee) to Deposit Account No. 50-0238 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17, particularly extension of time fees.

Respectfully submitted,

VOLENTINE FRANCOS & WHITT, P.L.L.C.

Date: March 20, 2007

By:


William S. Francos, Esq.
Registration No. 38,456

VOLENTINE FRANCOS & WHITT, P.L.L.C.
One Freedom Square
11951 Freedom Drive, Suite 1260
Reston, Virginia 20190
Telephone No.: (571) 283.0720
Facsimile No.: (571) 283.0740

Attachment: One (1) Replacement Sheet of Drawings